

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

McLachlan *et al.*

Appl. No.: 10/764,604

Filed: January 27, 2004

For: **Compositions and Methods for
Treating Cancer Using IGSF9 and
LIV-1**

Confirmation No.: 6570

Art Unit: 1642

Examiner: Lei Yao

Atty. Docket: 2159.0030001/EKS/PAC

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated October 20, 2005, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by the Examiner as claims 9-18 and 32-33. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

This election is made without prejudice to or disclaimer of the other claims or subject matter disclosed. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144. Applicants assert the right to claim additional species in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a).

Applicants respectfully traverse the restriction requirement as it applies to Groups I-XII. It is the Examiner's position that the polypeptides, polynucleotides and antibodies of Groups I-XII are patentably independent and distinct inventions. However, even where two patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of all groups together would entail a "serious burden". See MPEP § 803. In the present situation, the Examiner has not made such a showing.

Applicants respectfully traverse the restriction requirement as it applies between Groups I, II and VI. Applicants submit that a search of the antibodies of Group I would provide sufficient information for examination regarding the compositions and methods of Groups II and VI such that an examination would not place a serious burden on the examiner.

Thus, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

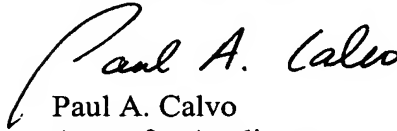
In addition, the Examiner has required a further election of one of the polypeptide or polynucleotide sequences represented as SEQ ID NOs: 2-6, 8, 12-27 and 29. Applicants hereby provisionally elect the polypeptide sequence of SEQ ID NO:2. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Consideration and allowance of all pending claims are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees

required therefor are hereby authorized to be charged to our Deposit Account No.
19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in cursive script that reads "Paul A. Calvo".

Paul A. Calvo
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Date: January 20, 2006

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